

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Number : 09/599,602 Confirmation No.: 1459
Applicant : Robert J. Rosko
Filed : June 23, 2000
Title : System and Method for Implementing a Consolidated Application
Process
TC/Art Unit : 3624
Examiner: : Daniel S. Felten

Docket No. : 47004.000073
Customer No. : **21967**

MAIL STOP Appeal Brief - Patent

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUBSTITUTE APPEAL BRIEF

Sir:

Appellant appeals the rejection of claims 1-19 set forth in the Office action mailed February 10, 2005 (hereinafter Office action). Any fees that may be due may be charged to Deposit Account No. 50-0206.

Five prior Briefs have been submitted in this application. Accordingly, this Appeal Brief repeats much of the information set forth in the prior Appeal Briefs, while fully responding to the rejections set forth in the Office action. The prior Appeal Brief filed November 10, 2003, the Supplemental Appeal Brief filed April 20, 2004, the Appeal Brief filed May 6, 2005, the Appeal Brief filed August 29, 2005, and the Substitute Appeal Brief filed May 14, 2007, are hereby incorporated by reference to the extent that any relevant material is omitted from this brief.

Real Party in Interest

The real party in interest is Bank One Corporation now doing business as J. P. Morgan Chase & Co., and having a place of business at 277 Park Avenue, New York, New York 10017.

Related Appeals and Interferences

Appellant appeals the rejection of claims 1-19 presented in the Office action mailed February 10, 2005. This Appeal Brief fully addresses the rejections of claims 1-19 presented in the February 2005 Office action.

To the best of appellant's knowledge, there are no related appeals or interferences.

Status of Claims

Claims 1-19 are pending and stand rejected. The rejections of claims 1-19 are appealed.

Status of Amendments

No amendments to the claims have been submitted in response to the recent Office action.

Summary of Claimed Subject Matter

The present invention provides a consolidated application system that comprises a dynamic application module. (Spec. p. 1, ll. 5-8; p. 6, ll. 4-8; Fig. 1, 34.) Users choose one or more services provided through a networked service provider. (Spec. p. 7, l. 10 - p. 8, l. 16; Fig. 2, 50.) Then, the dynamic application module presents the customer with a consolidated application, which is partially completed with information that is known about the customer. (Spec. p. 8, l. 17 - p. 11, l. 5; Fig. 2, 400.) After the customer completes the blank portions of the application, the dynamic application module sends the application to another server for real-time processing. (Spec. p. 7, l. 1-9; p. 11, l. 6 - p. 12, l. 7; Fig. 2, 600.)

Appellant's invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. (Spec. p. 1, ll. 5-7.) The invention is directed particularly to tailoring an application form to a particular request from an applicant. (Spec. p. 3, ll. 7-10.) Thus an applicant may apply for multiple requested products, such as banking products, by completing a single application form tailored to the applicant's request. (Spec. p. 8, l. 21 - p. 9, l. 2.) As an example, a potential applicant may chose from an array of products offered by a product provider, such as a bank. (Spec. p. 8, ll. 2-4.) The potential applicant may request to apply for a checking account and a credit card account. (Spec. p. 8, ll. 20-21.) The instant invention then dynamically creates an application form to solicit the information required to apply for both a checking account and a credit card. (Spec. p. 10, ll. 1-4.) In this manner, the applicant provides the required information to the bank in one convenient action.

Grounds of Rejection to be Reviewed on Appeal

The issue on appeal is generally whether the teaching of the applied references is properly combined to render obvious the pending claims. Specifically, appellants request review of the rejection of claims 1-19 as being unpatentable under 35 U.S.C. § 103(a) over U.S. Patent 6,385,894 in view of U.S. Patent Application Publication 2001/0047307.

Argument

Rejections under 35 U.S.C. § 103

The recent Office action fails to establish a *prima facie* case of obviousness that the pending claims are unpatentable over U.S. Patent 6,385,594 issued to Douglas Lebda and Richard Stiegler (Ledba) in view of U.S. Patent Application Publication 2001/0047307 naming as inventors James D. Bennett and Christopher C. Winslade (Bennett). “During patent examination the PTO bears the initial burden of presenting a *prima facie* case of unpatentability.” *In re Glaug*, 283 F.3d 1135, 62 U.S.P.Q.2d 1151, 1152 (Fed. Cir. 2002). “If the PTO fails to meet this burden, then the applicant is entitled to the patent.” *Id.* “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int. 1985). The references applied in the Office action fail to suggest the claimed invention for at least the reasons set forth with regard to each claim below. An artisan of ordinary skill would not have found the claimed invention to have been obvious in light of the teaching of the applied references. As the Examiner has not presented a *prima facie* case of unpatentability, appellant is entitled to a patent.

“The ‘*prima facie* case’ notion . . . seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the *prima facie* case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument.” *In re Oetiker*, 977 F.2d 1443, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992)(Plager, J., concurring). The Office action makes no attempt to explain the relevance of any teachings of the applied references with regard to the claimed invention. Rather, the rejection merely states that the references teach certain elements of the claimed invention and supports these statements with citations to the applied references. “The pertinence of each reference, if not apparent, must be clearly explained.” 37 C.F.R. § 1.104(c)(2). The mere citations to the applied references do not present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious in light of the teachings of the applied references.

Lack of Motivation to Combine Applied References

A proper rejection under 35 U.S.C. § 103(a) should set for the following:

- (A) the relevant teaching of the prior art relied upon . . . ,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

M.P.E.P. § 706.02(j) (8th Ed., Rev. 2) (2004). The Office action fails to propose how the primary reference to Lebda could be modified according the teaching of the secondary reference, Bennett, to arrive at the claimed subject matter. The explanations why one of ordinary skill in the art would have been motivated to combine the references are insufficient to establish a *prima facie* case of obviousness.

The Office “can satisfy [the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness] only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The motivations for combining references provided in the Office action are insufficient.

[A]n examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that

the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In *re Rouffet*, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). In the Office action, the Examiner merely asserts the advantages of individual features of the Bennett reference. No motivation for selecting the particular elements for combination with the teaching of the primary reference to Lebda is set forth. There is no support in the prior art for the proposition that the skilled artisan would have selected and combined the teachings relied upon by the Examiner to solve any problem.

Appellant sets forth in further detail below specific reasons why the recent Office action fails to establish a *prima facie* case of obviousness for each pending claim.

Bennett Not Available as Prior Art

The Office action does not establish that the secondary reference, Bennett, is available as prior art against appellant's claims. The instant application was filed June 23, 2000. Bennett is a U.S. Patent Application Publication filed November 29, 2001. Bennett on its face states that it is a non-provisional of provisional application No. 60/190,825 filed on March 21, 2000 ('825 provisional application). Bennett incorporates the '825 provisional application by reference.

The critical reference date under 35 U.S.C. § 102(e) of a U.S. application publication entitled to the benefit of the filing date of a provisional application under 35 U.S.C. § 119(e) is the filing date of the provisional application only if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. M.P.E.P. § 2136.03 III. The critical reference date of Bennett is not March 21, 2000. The '825 provisional application does not support the subject matter relied upon to make the rejections set forth in the Office action. The '825 provisional application is a business plan for launching a business providing loan qualification screenings during the automobile purchase process.

The Office action principally relies on Bennett to teach receiving one application for potentially many different types of credit. Appellant submits that Bennett does include such teaching for reasons discussed below. However, even if the Examiner's position regarding the

teaching of Bennett is assumed to be true for the sake of argument, the '825 provisional application does not support such teaching. The Office action at page 3, cites to paragraph 81 of Bennett to teach a request to apply for a plurality of products. The cited paragraph of Bennett sets forth that the approval system credit analysis differs as a function of the item for which the loan is being sought. "For example, depending on whether the loan is being sought to purchase an automobile, a home, or to repay revolving credit, the credit reporting/approval system software (S/W) 560 is operable to accommodate the different manner in which parameters corresponding to the buyer are handled." Bennett, para. 81. The '825 provisional application is directed solely to automobile purchases. The '825 provisional application does not support the teaching of a credit analysis that differs as a function of the item for which a loan is sought. To the contrary, the '825 provisional application at page 14 describes: "Our AutoAfford™ platform determines loan affordability by analyzing the buyer's credit information in view of the loan requirements of each of our participating lenders." The '825 provisional application is silent regarding loans sought to purchase a home or to repay revolving credit. The '825 provisional application does not support the subject matter relied upon to make the rejections in the Office action. Thus, the critical reference date of Bennett is not the March 21, 2000, filing date of the '825 provisional application. Accordingly, Bennett is not available as prior art against the pending claims. Appellant respectfully requests that the rejections based on Bennett be reversed as the Examiner has failed to establish that Bennett is available as prior art against appellant's claims.

The Applied Art Fails to Suggest the Claimed Subject Matter

Notwithstanding the availability of Bennett as prior art, the applied references do not show or suggest the claimed subject matter. As discussed above, the claimed invention is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. Neither of the applied references is directed to or suggests dynamically creating an application as set forth by the pending claims.

The primary reference, Lebda, is directed to coordinating an electronic credit qualification form between an Internet user and plurality of lending institutions via the Internet. The Lebda invention allows for applying for credit from a multitude of lending institutions without physically going to or calling each lender and filling out multiple applications. The

Lebda invention, thus, provides “a universal credit qualification form over the Internet and [allows] the Internet user to submit a single credit application to a plurality of lending institutions who then make offers to the customer via the Internet.” Lebda, col. 1, ll. 53-57. Lebda, thus, uses a universal credit form that obtains all the information that may be required to apply to any participating lender. Lebda does not suggest a dynamically created application form that is assembled for display to the user. To the contrary, Lebda simply “sends an open application to a prospective borrower through the Internet.” Lebda, col. 4, ll. 2-3.

The secondary reference, Bennett, is directed to an online affordability-based purchasing system that enables a buyer to obtain financing for products the buyer desires to purchase on credit. The Bennett system obtains information about a buyer. Bennett, without elaboration, states: “A buyer, via the buyer interface (IF) 120, provides buyer information to the credit analysis engine 140.” Bennett, para. 43. Bennett does not suggest that this information is obtained through dynamically created application forms. Bennett, to the contrary, suggests the use of multiple forms to obtain credit approval. “The loan origination software 424 provides to the buyer for completion via the buyer’s browser/user interface 460, all the necessary financing forms, etc.” Bennett, para. 74.

Appellant’s invention, as defined by the pending claims, is a method or system for providing a dynamically created application form through a network to a consumer applicant for one or more products. (Spec. p. 1, ll. 5-7.) The invention is directed particularly to tailoring an application form to a particular request from an applicant. (Spec. p. 3, ll. 7-10.) Thus an applicant may apply for multiple requested products, such as banking products, by completing a single application form tailored to the applicant’s request. (Spec. p. 8, l. 21 - p. 9, l. 2.) As an example, a potential applicant may chose from an array of products offered by a product provider, such as a bank. (Spec. p. 8, ll. 2-4.) The potential applicant may request to apply for a checking account and a credit card account. (Spec. p. 8, ll. 20-21.) The instant invention then dynamically creates an application form to solicit the information required to apply for both a checking account and a credit card. (Spec. p. 10, ll. 1-4.) In this manner, the applicant provides the required information to the bank in one convenient action.

The applied references fail to show or suggest any assembly or dynamic creation of a consolidated application page. Accordingly, the applied prior art fails to suggest the specific

details of appellant's invention as set forth in the pending claims. The details of the features absent from the applied art are discussed further below.

Claim 1

Claim 1 sets forth a method for dynamically creating an application form. The method includes steps of receiving a request to apply for a plurality of products, assembling an application page from a plurality of documents each of which contains a field corresponding to specific information required to apply for a product, and receiving information corresponding to each field in the application page. The instant specification describes a particular preferred embodiment of the claimed invention. In this embodiment, an Internet banking services provider receives a potential customer's request to apply for products such as a checking account and a credit card account offered by the provider. (Spec. p. 7, ll. 16-17; p. 8, ll. 11-16.) An application page is assembled and provided to the customer. (Spec. p. 9, ll. 17-18.) The application page requests only information required to apply for both the checking account and the credit card. (Spec. p. 9, l. 17 - p. 10, l. 4.) The customer may then complete the application through the application page provided and cause the completed application to be sent to the provider. (Spec. p. 11, ll. 7-8.) The applied combination of references fails to show or suggest the steps set forth in claim 1.

Claim 1 sets forth a step of "assembling an application page for display over the network, said page assembled from a plurality of documents." Column 3, lines 58-61, of Lebda is relied upon in the Office action to show this step. Lebda does not suggest assembling one application page assembled from a plurality of documents. Lebda is silent regarding using a plurality of documents to assemble a consolidated application page. Lebda does suggest sending a prospective borrower background information documents concerning a loan application. Lebda, col. 3, ll. 63-64. "These background information documents include a document welcoming the Internet user to the web site, a document explaining the application process, and a document explaining the services provided." Lebda, col. 3, l. 65 - col. 4, l. 1. The citation at column 3, lines 58-61 relied upon by the Office action, sets forth that a central loan processing computer allows prospective borrowers using satellite computers to view these documents. Lebda does not suggest assembling an application page from these documents. To the contrary, after these documents are sent, the loan processing computer sends an open application to the prospective

borrower through the Internet to the satellite computer. Lebda, col. 4, ll. 1-3. Lebda does not suggest that this application is assembled from a plurality of documents.

Appellants note that an advantage of assembling the application page, is that a single application is presented to the user to apply for a plurality of products. The Office action acknowledges that Lebda does not teach a request to apply for a plurality of products. Accordingly, it is not surprising that Lebda does not suggest assembling an application page. There is no advantage to assembling such a page in the Lebda system.

The Office action appears to assert that Lebda teaches receiving a request to apply for a single product. In the Office action it is asserted: "It would have been obvious to one of ordinary skill in the art at the time appellant's invention was made to combine the teachings of Lebda relating to presenting and accepting a credit application over a network to include the teachings of Bennett relating to receiving one application for potentially many different types of credit." This combination of the teaching of Lebda and Bennett is insufficient to establish a *prima facie* case of obviousness against claim 1 for at least three reasons. First, the Office action does not set forth the proposed modification to the Lebda system based on the teaching of Bennett necessary to arrive at the claimed invention. Second, the Office action does not provide a sufficient explanation why one of ordinary skill in the art would have been motivated modify the teachings of the references relied upon. Third, Bennett does not suggest receiving one application for different credit products.

Claim 1 sets forth a step of "receiving a request to apply for a plurality of products, the request received over a network." As acknowledged in the Office action, Lebda does not suggest a request to apply for a plurality of products. Neither does Bennett. As discussed above, Bennett is directed to a system that enables a buyer to obtain financing for those products the buyer desires to purchase on credit. No application is required to purchase the products. The buyer, however, may apply for credit to buy the products. The credit analysis performed is a function of the products for which the loan is sought. This is the disclosure of paragraph 81 of Bennett, which is relied upon in the Office action to show a request to apply for a plurality of products. Bennett, however, includes no suggestion to apply for a plurality of loans.

Claim 1 further sets forth that "specific information is required to be submitted to apply for each one of the plurality of products." Paragraph 81 of Bennett is relied upon in the Office action to show this limitation. The Bennett system "is operable to accommodate the different

manner in which parameters corresponding to the buyer are handled.” Bennett, para. 81. The Office action does not demonstrate that Bennett suggests that specific information is required to be submitted to apply for each of a plurality of loans. The cited paragraph of Bennett simply discloses that a different credit analysis is performed to the buyer’s information based on the items to be purchased.

Claim 1 further sets forth qualities of the plurality of documents from which the application page is assembled. “[E]ach document of the plurality of documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products.” The Office action acknowledges that Lebda does not teach this limitation. The Office action, relies on paragraph 18 of Bennett, to show this limitation. This reliance is misplaced. Bennett does not suggest assembling an application page from a plurality of documents. Bennett is silent regarding documents containing fields corresponding to specific information required to apply for products such as loans. Paragraph 18 discloses that an individual using a computer may respond to credit pre-approval via a web page or web pages to initiate purchase of one or more products using financing. Nothing in paragraph 18 suggests that the web pages are assembled from documents that contain fields corresponding to specific information required to apply for one of a plurality of products.

Neither Lebda nor Bennett suggests a request to apply for a plurality of products. The Office action does not set forth a proposed modification of the applied references necessary to arrive at the subject matter of claim 1 including a step of receiving a request to apply for a plurality of products. Likewise, neither Lebda nor Bennett suggests a step of assembling an application page from a plurality of documents. The Office action does not set forth a proposed modification of the applied references necessary to arrive at the subject matter of claim 1 including a step of assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products.

The Office action fails to set forth a sufficient explanation of why one of ordinary skill in the art would have been motivated to modify the teaching of the applied references. The Office action asserts it would have been obvious to combine the teaching of Lebda to include the teaching of Bennett relating to receiving one application for potentially many different types of

credit. The Office action asserts that the motivation for this combination “is simply to save time and expense” as indicated in paragraph 7 of Bennett. Bennett does not show or suggest receiving one application for potentially many different types of credit. Paragraph 7 of Bennett asserts that conventional loan approval methods are time-consuming and often involve a considerable amount of wasted effort. Nothing in Bennett suggests that the teaching therein would save additional time and expense if combined with the innovative method of co-ordinating a loan application to a plurality of lending institutions of Lebda.

For at least the above reasons, the Office action fails to set forth a *prima facie* case of obviousness against claim 1. Neither Lebda nor Bennett suggests a request to apply for a plurality of products. Accordingly, neither Lebda nor Bennett suggests assembling an application page assembled from a plurality of documents, wherein each document contains a field corresponding to specific information required to apply for one the plurality of products. The bare citations to the applied references fail to present a convincing line of reasoning as to why an artisan would have found the claimed invention to have been obvious. Appellant, therefore, respectfully requests that this rejection of claim 1 be reversed.

Claim 2

Claim 2 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 2 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 2 are discussed below.

Claim 2 further sets forth validating information input. When the information input fails to correctly compare to validation criteria, a second application page is assembled including prompts to reenter information. (Spec. p. 11, ll. 6-17.) The Office action at page 4 acknowledges that this limitation is not taught by the applied art. Official Notice is taken that reoffering a web page for completion, after discovering validation errors is old and well known in the art. The Office action asserts that it would have been obvious to combine the teaching of Lebda to include a re-presentation of a web page upon the discovery of errors. Such modification of Lebda is insufficient to arrive at the claimed subject matter. Claim 2 sets forth “assembling a second application page including prompts to reenter information.” The Office action does not assert that is known to assemble a second application page upon discovery of

errors. Should the Examiner be taking Official Notice that such assembly is old and well known, appellant traverses such Official Notice.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Lebda in view of Bennett does not show or suggest the steps of the invention defined by dependent claim 2. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 2. Appellant respectfully requests that the rejection of claim 2 over Lebda in view of Bennett be reversed.

Claim 3

Claim 3 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 3 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 3 are discussed below.

Claim 3 includes the step of forwarding the information input to a decision module for processing the information input. (Spec. p. 11, ll. 18-20.) The Office action at page 4 relies on column 4, lines 42-45, of Lebda to show this limitation. This sentence of the Lebda specification is silent regarding forwarding information to any location.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Lebda in view of Bennett does not show or suggest the steps of the invention defined by dependent claim 3. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 3. Appellant respectfully requests that the rejection of claim 3 over Lebda in view of Bennett be reversed.

Claim 4

Claim 4 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 4 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 4 are discussed below.

Claim 4 includes the steps of determining whether the request to apply originates from a customer that is logged in to a session manger, and accessing stored data regarding the customer if the customer is logged in. The step of assembling an application page is further defined to include inserting the stored data in the application page. The steps of claim 4 permit the claimed system to use secure information regarding a customer to prefill fields in an application form for

a product when information required to apply for the product is already known to the product provider. (Spec. p. 10, ll. 14-19.)

The Office Action at pages 4-5 relies on the dynamic personal web page set forth in claim 21 of Lebda at column 10, lines 56-67. Lebda does not suggest that stored data regarding a customer is inserted in an application page on the dynamic personal web page. The Lebda personal web page is not used to apply for a loan. To the contrary, Lebda sets forth “publishing a decision of each identified lending institutions . . . on the dynamic personal web site.” Lebda, col. 10, ll. 58-60. Accordingly, the dynamic personal web page of Lebda does not suggest inserting stored customer data in an application page as set forth by claim 4.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Lebda in view of Bennett does not show or suggest the steps of the invention defined by dependent claim 4. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 4. Appellant respectfully requests that the rejection of claim 4 over Lebda in view of Bennett be reversed.

Claim 5

Claim 5 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 5 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 5 are discussed below.

Claim 5 sets forth that the plurality of products applied for includes banking products and the information required to apply for one of the products includes information regarding an amount of credit to be extended. At page 5 of the Office action, it is asserted that Lebda teaches this limitation. This assertion is contrary to the acknowledgment with respect to claim 1 that Lebda does not teach that a request to apply for a plurality of products. As Lebda does not suggest a request to apply for a plurality of products, Lebda does not suggest a request to apply for a plurality of banking products.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Lebda in view of Bennett does not show or suggest the steps of the invention defined by dependent claim 5. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 5. Appellant respectfully requests that the rejection of claim 5 over Lebda in view of Bennett be reversed.

Claim 6

Claim 6 depends from claim 5 and therefore includes each step of the method of claim 5. The rejection of claim 6 is deficient for the reasons set forth above with respect to claim 1 and 5. Further significant defects of the applied references as applied to claim 6 are discussed below.

Claim 6 further sets forth forwarding the information input to a decision module for processing to determine if data input justifies extension of credit. The Office action at page 5, merely cites to column 4, lines 42-45, of Lebda to show this limitation. The cited sentence states: "FIGS. 6, 7, and 8 show stage 6 of the process, wherein computer 100 runs a filter to match completed application 115 in table 150 against preset criteria established by each lender." This citation of Lebda is silent regarding processing to determine if data input justifies extension of credit.

For at least the reasons set forth with respect to claims 1 and 5 and the further specific reasons set forth above, the Office action does not establish a *prima facie* case of obviousness against claim 6. Appellant respectfully requests that the rejection of claim 6 over Lebda in view of Bennett be reversed.

Claim 7

Claim 7 depends from claim 1 and therefore includes each step of the method of claim 1. The rejection of claim 7 is deficient for the reasons set forth above with respect to claim 1. Further significant defects of the applied references as applied to claim 7 are discussed below.

Claim 7 sets forth that the request is in the form of parameters received within a universal resource locator (URL). The Office action at page 3, cites to column 3, lines 52-55, of Lebda to show this limitation. The cited passage merely states computers interact through the Internet. Lebda goes on to state that a web-page is housed in a loan processing computer at a predetermined URL address. Lebda, col. 3, ll. 56-58. This disclosure teaches away from the limitation of claim 7. Lebda disclosed a *predetermined* URL address for accessing a web page. In contrast, claim 7 sets forth that a specific request to apply for a plurality of products is in the form of parameters received in within a URL. The URL is thus created with varying parameters based on the products requested. The predetermined URL address of Lebda is contrary to the inclusion of differing parameters as set forth by claim 7.

For at least the reasons set forth with respect to claim 1 and the further specific reasons set forth above, Lebda in view Bennett does not show or suggest the steps of the invention defined by dependent claim 7. Accordingly, the Office action does not establish a *prima facie* case of obviousness against claim 7. Appellant respectfully requests that the rejection of claim 7 over Lebda in view of Bennett be reversed.

Claims 8 and 13

Claim 8 sets forth a system for obtaining application data from an applicant through a dynamically created application form. The claimed system includes a dynamic application module and a decision module. (Spec. p. 6, ll. 4-6.) The dynamic application module receives requests to apply for at least one of a plurality of products, dynamically creates an application requesting data required to apply for the requested products, and receives the requested data. (Spec. p. 7, l. 15 - p. 11, l. 5.) The decision module receives the data, generates a decision regarding the application, and provides the decision to the dynamic application module. Spec. p. 11, l. 18 - p. 12, l. 7.) The applied art does not show or suggest the dynamic application module set forth by claim 8.

Claim 8 sets forth a dynamic application module. The dynamic application module is for receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one of a plurality of products, and receiving the data requested. The Office action at page 5, cites to Lebda at column 7, lines 23-29, to show this limitation. The following steps of claim 1 of Lebda are recited at lines 23-29 of column 7: “receiving a plurality of credit data sent from the Internet user;” and “applying said credit data to a filter comprising the plurality of selection criteria of the database to select without manual intervention each one of said plurality of lending institutions associated with a match of said credit data to said selection criteria.” The steps of claim 1 of Lebda do not suggest dynamically creating an application requesting data required to apply for at least one of a plurality of products. As discussed above, the Lebda invention provides “a universal credit qualification form over the Internet and [allows] the Internet user to submit a single credit application to a plurality of lending institutions who then make offers to the customer via the Internet.” Lebda, col. 1, ll. 53-57. There is no suggestion in Lebda that the universal credit qualification form is dynamically created. The secondary reference to Bennett includes no

suggestion to dynamically create an application. Accordingly, applied art does not suggest a dynamic application module for dynamically creating an application requesting data required to apply for at least one of a plurality of products as set forth by claim 8.

Claim 8 sets forth a decision module in communication with the dynamic application module. The decision module is for receiving the data, generating a decision regarding the application, and providing the decision to the dynamic application module. The Office action, interprets module “to include any collection of hardware or software processes such that the result is effectuated.” The Office action cites to further steps of claim 1 of Lebda to show the decision module. The Office action identifies no collection of hardware or software processes that effectuate the steps of claim 1 of Lebda that are relied upon show the claimed function of either the dynamic application module or the decision module. Claim 8 sets forth that the decision module is for providing the decision to the dynamic application module. As the Office action does not identify either a dynamic application module or a decision module in Lebda, there is no suggestion of a decision module for providing a decision to a dynamic application module.

For at least the reasons set forth above, Lebda in view of Bennett does not show or suggest the components of the system defined by claim 8. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 8. Appellant respectfully requests that this rejection of claim 8 be reversed.

Claim 13 depends from claim 8 and therefore includes each element of the system of claim 8. The rejection of claim 13 is deficient for the reasons set forth above with respect to claim 8. Appellant respectfully requests that the rejection of claim 13 be reversed.

Claims 9 - 12

Claim 9 depends from claim 8 and therefore includes each element of the system of claim 8. The rejection of claim 9 is deficient for the reasons set forth above with respect to claim 8. Further significant defects of the applied references as applied to claim 9 are discussed below.

Claim 9 further sets forth that the system includes a universal session manager and a profile database. The universal session manager verifies the originator of the request received by the dynamic application module. The profile database provides stored data regarding the originator of the request. The Office action at page 6, relies on column 8, lines 4-9, of Lebda to

show the limitations of claim 9. This citation is to claim 3 of Lebda, which includes a step of “verifying data input in a credit qualification form on a web site.” This step of the Lebda method cited is directed to verifying that the data entered to a web site is in the correct form. In contrast, the claimed universal session manger creates a verification of the originator of the request. The universal session manger verifies the identity of the originator of the request. Lebda does not suggest a universal session manger as set forth by claim 9.

For at least the reasons set forth with respect to claim 8 and the further specific reasons set forth above, Lebda in view Bennett does not show or suggest the steps of the invention defined by dependent claim 9. Accordingly, the final Office action does not establish a *prima facie* case of obviousness against claim 9. Appellant respectfully requests that the rejection of claim 9 over Lebda in view of Bennett be reversed.

Claims 10 -12 depend from claim 9 and therefore include each element of the system of claim 9. The rejection of claims 10 - 12 are deficient for the reasons set forth above with respect to claim 9. Accordingly, appellant respectfully requests that the rejection of claims 10 -12 over Lebda in view of Bennett be reversed.

Claim 14

Claim 14 defines a method for dynamically creating an application form in a manner similar to claim 1. Claim 14 further sets forth that the request to apply for at least one of a plurality of products is in the form of a uniform resource locator, similar to the limitation of claim 7. (Spec. p. 8, ll. 11-14.) Claim 14 also includes the step of parsing the uniform resource locator to identify the products. (Spec. p. 8, ll. 14-16.) Claim 14 includes all the steps and limitations discussed above with respect to claim 1. Claim 14 is rejected for the same reasons as claim 1 and 7. Accordingly, Lebda in view of Bennett does not show the method of claim 14 for at least the reasons discussed above with respect to claims 1 and 7.

Claim 14 sets forth a step of “parsing the uniform resource locator to identify that at least one of a plurality of products.” The Office action at page 3 asserts that access to any web page is implied in a URL. However, the URL set forth in claim 14 is not merely used to access a web page. It is further used to transmit a request to apply for selected products. The URL must therefore be parsed to identify which products are requested. An application page is then assembled to provide an application for the products requested. The Office action reliance on

accessing web pages with a URL is insufficient to suggest parsing the URL to identify requested products as set forth by claim 14. Appellant respectfully requests the reversal of the rejection of claim 14 over Lebda in view of Bennett as these references fail to render claim 14 obvious for the same reasons as discussed above and with respect to claims 1 and 7. The Office action does not establish a *prima facie* case of obviousness against claim 14 for the reasons set forth above and with respect to claims 1 and 7.

Claims 15-19 dependent from Claim 14

Claims 15-19 are identical to claims 2-6 but for depending from claim 14. Claims 15-19 are rejected for the same reasons as claims 2-6. Lebda in view Bennett does not show or suggest the invention as defined by claims 15-19 for at least the reasons discussed above with respect to claim 14 and claims 2-6. The Office action fails to establish a *prima facie* case of obviousness against claims 15-19 for the reasons set forth above with respect to claims 1-6 and 14. Appellant respectfully requests that the rejections of claims 15-19 be reversed for the reasons set forth above.

Conclusion

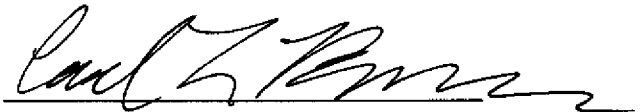
The claimed invention relates to the dynamic creation of an application form, that is a form for submitting information to apply for products and services. The applied prior art is silent regarding the creation of an application form. Accordingly, the applied prior art cannot suggest the invention set forth by the pending claims. Appellant has replied to every rejection set forth in the Office action in the above remarks. Each rejection has been shown deficient or overcome for the reasons set forth above. Accordingly, appellant submits that pending claims 1-19 are patentably distinguishable over the prior art of record. Appellant requests that the rejections be reversed, the application be returned to the Examiner and the claims allowed.

Respectfully submitted,

HUNTON & WILLIAMS LLP

Dated: May 14, 2007
Hunton & Williams LLP
Intellectual Property Department
1900 K Street, N.W.
Suite 1200
Washington, DC 20006-1109
(202) 955-1500 (telephone)
(202) 778-2201 (facsimile)

By:


Carl L. Benson
Registration No. 38,378

Claims Appendix

1. A method for dynamically creating a network based application form comprising the steps of:
 - receiving a request to apply for a plurality of products, the request received over a network, wherein specific information is required to be submitted to apply for each one of the plurality of products;
 - assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and
 - receiving information input corresponding to each field contained in the application page.
2. The method of claim 1, further including the steps of:
 - validating the information input by comparing the information input to validation criteria; and
 - when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.
3. The method of claim 1, further including the step of forwarding the information input to a decision module for processing the information input.
4. The method of claim 1, further including the steps of:
 - determining whether the request to apply originates from a customer that is logged in to a session manager;

accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

5. The method of claim 1 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.

6. The method of claim 5 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.

7. The method of claim 1 wherein the request is in the form of parameters received within a universal resource locator.

8. A system for obtaining application data from an applicant through a dynamically created network based application form comprising:

a dynamic application module for receiving a request to apply for at least one of a plurality of products, dynamically creating an application requesting data required to apply for the at least one a plurality of products, and receiving the data requested; and

a decision module in communication with said dynamic application module, said decision module for receiving the data, generating a decision regarding the application, and providing the decision to said dynamic application module.

9. The system according to claim 8 further comprising:

a universal session manager in communication with said dynamic application module, said universal session manager for creating a verification of an originator of the request; and

a profile database in communication with said dynamic application module, said profile database for providing stored data regarding the originator of the request.

10. The system according to claim 9 further comprising a host server wherein said dynamic application module, said universal session manager and said database reside on said host server.

11. The system according to claim 10 wherein said host server is connected to a network.

12. The system according to claim 11 wherein said dynamic application module provides the application in the form of an application page over the network to the originator of the request.

13. The system according to claim 8 further including a processing database in communication with said dynamic application module, said processing database for receiving data regarding use of said dynamic application module.

14. A method for dynamically creating a network based application form comprising the steps of:

receiving, over a network, a request to apply for at least one of a plurality of products in the form of a uniform resource locator, wherein specific information is required to be submitted to apply for each one of the plurality of products;

parsing the uniform resource locator to identify the at least one of a plurality of products;

assembling an application page for display over the network, said page assembled from a plurality of documents, wherein each document of the plurality of

documents contains at least one field corresponding to the specific information required to apply for one of the plurality of products; and

receiving information input corresponding to each field contained in the application page.

15. The method of claim 14, further including the steps of:

validating the information input by comparing the information input to validation criteria; and

when the information input fails to correctly compare to the validation criteria, assembling a second application page including prompts to reenter information and receiving corrected information input.

16. The method of claim 14, further including the step of forwarding the information input to a decision module for processing the information input.

17. The method of claim 14, further including the steps of:

determining whether the request to apply originates from a customer that is logged in to a session manager;

accessing stored data regarding the customer if the customer is logged in, wherein the step of assembling an application page includes inserting the stored data in the application page displayed over the network.

18. The method of claim 14 wherein the plurality of products includes banking products and the specific information required to apply for one of the plurality of products includes information regarding an amount of credit to be extended.

19. The method of claim 18 further including the step of forwarding the information input to a decision module for processing the information input to determine if data input justifies extension of credit.

Evidence Appendix

None.

Related Proceedings Appendix

To the best of appellant's knowledge, there are no related appeals or interferences.